

Claims 1, 2, 4 and 6 - 9 are rejected under 35 USC 103(a) as being unpatentable over Van Dam (U.S. 5,065,738) and Rooney et al (U.S. 5,656,014).

REMARKS

The claims are all believed to be definite and patentable as amended.

35 USC 112 Rejection

The claims are believed to now avoid a 35 USC 112, second paragraph, rejections.

All of the claims include “for a laryngoscope blade” in the preamble. If this functional statement of intended use does not provide an antecedent for “said laryngoscope blade” within the body of the claim, then it appears that “said” is the problem. Since the claims address “the” and not a combination including the blade, the reference is now only related to the blade the same as in the preamble. To overcome this perceived problem, in an effort to overcome the rejection, “said” has been replaced with - - the - - to avoid the perceived improper antecedent combination rejection. It is believed that this avoids any legal problem. If this does not satisfy the Examiner, the Examiner is given permission to change “the,” as inserted , to - - a - - or to call with any suggestions for solving the perceived problem.

35 USC 103(a) Rejections

Reconsideration of the 35 USC 103 rejection is requested.

In the first place:

Neither the patent to Van Dam nor the patent to Rooney et al, nor the two taken together, render even claim 1 obvious.

The present claim 1 requires: 1) a tongue-engaging plate, 2) a foam strip support attached to the plate, and 3) a pressure sensitive adhesive attached to the foam support.

There are three layers secured together in claim 1, and in every other claim, since all the claims depend from claim 1.

The patent to Van Dam teaches a two-layer sheath for attachment to a laryngoscope blade, the first a padding, the second an adhesive for securing the first to the blade (column 6, lines 48- 53). This is the sum and substance of the Van Dam sheath. The fact that the adhesive may have a throw-away protective cover for the adhesive does not constitute a third layer in use.

The patent to Rooney et al teaches a two-layer sheath for attachment to a laryngoscope blade; the first a plate, the second is an adhesive that bonds the plate to the blade (column 3, lines 13 - 15). This is the sum and substance of the Rooney et al sheath if, in fact, this plate can be considered to be a sheath which it is not. It is a cover plate. The fact that the plate and blade can

be encompassed with a throw-away condom type sanitary cover, i.e. pullover, does not constitute a three layer tongue stabilizer.

Patents that only teach two layers secured together cannot logically or legally render obvious a claim to a patent claim teaching three layers. This is especially true where each layer performs a different function and both patents fail to teach the claimed functions.

In the second place:

With due respect, the Examiner's interpretation of the Rooney et al patent is traversed. The portions of the tongue depressor of Rooney et al cited have nothing to do with the sheath. The sheath of Rooney et al is no more and no less than a cover that temporarily slips over the blade to be used once and then discarded. As disclosed in column 3, lines 33 - 61 and shown in Figs. 8 and 9, the sheath is a "sanitary sheath assembly comprising a transparent plastic sterile sheath 50 contoured and dimensioned to surround the depressor 10 from its proximal end 17 to its distal end portion 12." The depressor is completely inserted into the sheath 50

"Following the oral examination, the user separates the sheath 50 from the depressor 10 and discards the sheath" (column 4, lines 2 - 4). The sheath of Rooney et al does not prevent tongue movement, it covers, and prevents the "abrasive texture 65, fish scale-like surface etched into the surface 17 of Rooney et al, disclosed in column 3, lines 10 - 32 and shown in Fig. 5, from functioning as intended. The sheath renders the tongue stabilizer function inoperative if it has any substantial thickness and reduces its ability to perform its function if it has any thickness at all. In any event, it provides a slippery layer between the abrasive and tongue.

The patent to Van Dam is to a laryngoscope blade sheath. The sheath is adhesively attached to the blade. It provides a padding between the blade and patient's body parts (Abstract, Field of the Invention) "to deflect the tongue away from the lumen of the laryngoscope blade."

The blade 12 is used "to roll the tongue of a patient out of the way and allow the laryngoscopist to sight under the arc of the blade" (column 5, lines 9 - 11).

The sheath is placed on the blade "to provide protection to the mouth, teeth and throat from the much harder, albeit blunt, tip" of the blade (column 6, lines 41 - 47).

Since Rooney et al do not teach providing an abrasive texture on a sheath, they cannot logically or legally be considered to teach Van Dam to place such a surface on his sheath. Further, placing an abrasive texture on the sheath of Van Dam would render his sheath inoperative for its intended purpose. The sheath of Van Dam exists to protect the patient's teeth, and tongue and mouth and throat from being damaged during intubation. It is designed to slip over body parts and insulate them from frictional contact with the blade. The sheath is specifically designed to be flat, planar, pliable and a soft, pliable thermo-plastic foam (column 3, lines 17, 18, 50 and 51). The blade is designed to "roll the tongue of the patient out of the way" (column 5, lines 9 - 11). To make the sheath a friction surface would be in opposition to the teachings of Van Dam, and render it inoperative for performing its expressed purpose.

To texture the blade of Van Dam to any specific depth is pure speculation. To texture to a depth of 0.015 to 0.125 inch, finds no support in either reference. To then cover the 0.015 to 0.125 texture with the 0.125 to 0.250 inch sheath of Van Dam (column 6, lines 59 - 61) would be ludicrous in the eyes of anyone in the art, being a mechanic or novice having any common sense. The Examiner is not legally at liberty to mix the sheath teachings of one patent with the blade teachings of another patent unless specifically disclosed within one of the references. The Examiner is not legally at liberty to use the teachings of one patent to accomplish the opposite results in another patent. The Examiner is not legally at liberty to transpose dimensions, not found in one patent, into another patent to accomplish a function in opposition to the function in the former.

Claim 2 requires that the tongue-engaging plate forward end be rounded and that the rear end meet the sides in a rounded configuration. The rounding of the claimed plate 6 at 2 and 7 is clear. However, the blade end 17 of Rooney et al is flat and the rear is not rounded. The “sheath” 50 of Rooney et al has a flat end 58 and rear square corners (Fig. 8). The patent to Van Dam has a sheath that is not a plate, it is a foam padding, and while the front end may be rounded, the rear end does not have rounded rear corners.

Since neither patent teaches the claimed structure, the two together cannot teach or render the claim obvious.

Claim 4 requires that the tongue-engaging plate have a thickness of from 0.015 to 0.125 inch. The patent to Rooney et al has no plate, only a sanitary plastic sheath or cover pulled over the blade. The plate 48 is a part of and completely covers the blade for most of its length. There is no concern for, or need for concern for, sheath thickness. Van Dam has no plate only a padding and the padding is from 0.125 to 0.25 inch. The padding needs to be 1/8 inch or more to function as padding. There is nothing in either patent to suggest any specific thickness of the claimed plate. Neither patent has a plate comparable to that claimed. There is no teaching of or reason for performing the function, by either patent, that is comparable to that of the claimed plate. The patents cannot render obvious something they do not provide for.

Claim 6 requires that the tongue-engaging plate have a length of from 1 to 2 ½ inches long. Neither Rooney et al nor Van Dam teach the claimed plate. The sheath of Van Dam extends all but the entire length of the blade and that of Rooney et al encompasses the entire length of the blade. There is no suggestion whatsoever in Van Dam or Rooney et al of a support plate, let alone one that extends from 1 to 2 ½ inches long. The references cannot render obvious something they do not possess or address.

Claim 7 requires that the foam strip have a thickness of from 1/32 to 1/4 inch. Rooney et al has no foam layer or any reason to provide one. Van Dam does have a foam layer but it is not between a plate and adhesive as required by claim 1. It is for padding. The plate of the claim would render the function of Van Dam inoperative and the padding of Van Dam would render the plate claimed inoperative to perform its function. The patents of Rooney et al and

Van Dam do not render the claim obvious. The padding under a plate would not be padding and padding on the plate claimed would not prevent slippage.

Claim 8 requires a protective covering on the pressure sensitive adhesive bottom. The use of protective coverings over an adhesive is common and obvious per se. The fact that Van Dam teaches a protective layer for his adhesive is of little value insofar as the claimed combination is concerned. The claimed protective covering is over an adhesive attached to a foam layer attached to a plate. Rooney et al and Van Dam do not teach or suggest the structural combination or render it obvious.

Claim 9 requires that the foam strip have a width of 1/4 to 1/2 inch and a length of from 3/4 to 2 inches. Rooney et al have no foam strip. The foam strip of Van Dam extends the width of the blade and the length of the blade. If this were not so, the foam padding of Van Dam could not perform its padding function. To the contrary, the foam strip claimed is limited to supporting the plate and is limited in extent to support but be smaller than the plate. There is no teaching in Rooney et al or Van Dam of use of a foam strip to support a plate as claimed. They do not render the claim obvious.

The rejections violate established legal principles.

To be a valid rejection under 35 USC 103 requires a teaching within the four corners of the references to make the suggested device. The Court of Appeals for the Federal Circuit has

stated that combining separate teachings in prior art references to establish a case for obviousness must be based on a suggestion or motivation therefor in the prior art. W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983). A combination of prior art references requires consideration of whether the prior art would have suggested to those of ordinary skill in art that they should make claimed composition or device, or carry out claimed process, and whether prior art would also have revealed that such person would have reasonable expectation of success; both suggestion and reasonable expectation of success must be founded in prior art, not in applicant's disclosure. In re Vaeck, 20 USPQ2d, 1438 (CAFC 1991).

The references must provide the same solution to the same problem addressed by the claims. The relationship between the problem the inventor is attempting to solve and the problem involved in the prior art is highly relevant. Stanley Works v. McKinney Mfg., 216 USPQ 298 (DelDC 1981).

The prior art must address and provide the inventors answers to the particular problem in issue. In re Winslow, 151 USPQ 48 (CCPA 1966).

The references combined do not teach the claimed structure. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to

have been obvious in light of the teachings of the references. Ex parte Clapp, 227 USPQ 973 (POBdPatApp&Inter, 1985).

A reference that teaches away the invention cannot be used to reject it. When all the disclosures in a reference are considered, the overall suggestion to emerge from the prior art may be contrary to that which might appear from isolated portions of the reference. In re Hughes 193 USPQ 141 (CCPA 1977).

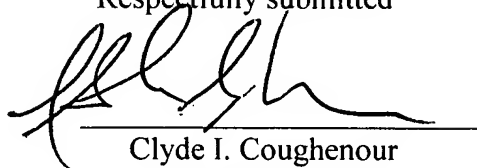
The rejection can only be the result of hindsight. In the case of In re Sponnoble, 160 USPQ 237, the former Court of Claims and Patent Appeals cautioned against the use of hindsight in view of the applicant's disclosure. The court said". . . we must view the prior art without reading into that art appellant's teachings", and further, "The issue, then is whether the teachings of the prior art would, in and of themselves and without the benefit of appellant's disclosure, make the invention as a whole obvious."

Claims 1, 2, 4 and 6 - 9 are not obvious over Van Dam and Rooney et al.

CONCLUSION

Claims 1 - 17 are now believed to be definite and in condition for allowance. Such action is earnestly solicited.

Respectfully submitted



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